

REMARKS

Claims 1-40 are pending in the above-referenced application. Claims 1, 13 and 26 have been amended. Claims 36-40 have been added. Reconsideration of the Examiner's rejections is respectfully requested in view of the foregoing amendments and the following remarks.

Support for amendments to claims 1, 13 and 26 can be found in the application as filed, for example, at p. 11, lines 12-23. Support for new claims 36-38 can be found, for example, at page 9, lines 29-30, and page 9, lines 15-16. Claims 39 and 40 are supported by the specification, for example, at page 9, lines 18-19 and page 9, line 26 – page 10, line 3. Thus, no new matter has been added.

Rejection of claims 1-9 and 26-32 under 35 USC 103(a) over Kuzuhara in view of Hommes

The Examiner has rejected claims 1-9 and 26-32 under 35 U.S.C. 103(a) as being unpatentable over Kuzuhara et al. US 2003/00156235 ("Kuzuhara") in view of Hommes et al. US 4,853,602 ("Hommes"). The Applicants traverse the Examiner's rejection and respectfully submit that the cited references do not teach, explicitly or inherently, all elements of any of the pending claims, and that it would not be obvious to a person of ordinary skill in the art to modify their disclosure to arrive at the subject matter of the pending claims with a reasonable expectation of success.

Kuzuhara is directed to a polarizing plate that includes a polarizing film and a cellulose ester retarder film. Applicants have amended independent claims 1, 13 and 26 to recite that the layer of biaxially stretched polyolefin or polymer film includes a crystallization modifier.

With regard to claim 1, the Examiner admits that Kuzuhara fails to disclose a simultaneously biaxially stretched polyolefin film. Moreover, the Applicants submit that Kuzuhara fails to disclose or suggest polymers that include a crystallization modifier. The polymers listed in the cited reference are amorphous polymer systems that do not exhibit a significant degree of crystallization. In fact, because Kuzuhara teaches solvent cast cellulose ester films, adding a crystallization modifier could harm optical properties of films, e.g., by producing significant amounts of haze. Such films would not be "non-scattering for at least one polarization state of visible light," as required by all independent claims of the present application and claims dependent thereon. Therefore, in addition to not teaching the use of a

polyolefin retarder film as claimed in the present application, the reference does not teach or suggest the use of a crystallization modifier in such a film.

Hommes does not fill the gaps in the disclosure of Kuzuhara, as it also does not teach or suggest a layer of simultaneously biaxially stretched polyolefin or polymer including a crystallization modifier that has an in-plane retardance (R_e) being 100 nm or less and an absolute value of an out-of-plane retardance (R_{th}) being 55 nm or greater. Hommes is directed to a system for drawing a web of material. It does not teach or suggest using such systems to make optical retarders. The uses of films produced according to Hommes are very different from those of the present application, as it is apparent from col. 36, lines 47-49, which states that a film made using such systems "is an outstanding candidate for use as a base film in magnetic recording tapes and disks, capacitors, etc."

Thus, the cited references do not teach or suggest at least the abovementioned elements of claims 1 and 26, as well as those of the claims dependent thereon and incorporating their limitations. In addition, motivation to modify or combine the Kuzuhara and Hommes to arrive at the claimed invention does not exist absent impermissible hindsight reconstruction. As the Examiner knows, § 2141 of MPEP recognizes the following basic considerations that apply to obviousness rejections:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.
Hodosh v. Block Drug Co., Inc., 786 F2d 1136, 1143 n.5 (Fed. Cir. 1986). (emphasis added).

With regard to the Examiner's rejection of claims 1 and 4-6, paragraph [0017] of Kuzuhara recites R_o of from 31 to 120. However, claims of the present application all require an in-plane retardance (R_o) being 100 nm or less. As it is apparent from the paragraph cited by the Examiner, Kuzuhara teaches the use of in-plane retardance values that are outside those claimed in the present application, and no motivation is provided to modify the disclosure of Kuzuhara to arrive at the claimed ranges. Furthermore, Kuzuhara does not disclose or suggest values of R_o of

85 nm or less, 20 to 50 nm or 50 to 100 nm, as required by claims 4-6, respectively, and no motivation is provided to modify the disclosure to arrive at these values.

With regard to the Examiner's rejection of claims 7 and 8, paragraph [0017] of Kuzuhara recites Rt of from 60 to 300 nm. As it is apparent from the paragraph cited by the Examiner, Kuzuhara teaches the use of out-of-plane retardance values that are outside those claimed in the present application (i.e., greater than 150 nm or greater than 200 nm), and no motivation is provided to modify the disclosure of Kuzuhara to arrive at the claimed ranges.

With regard to claims 9, 26 and 27, the Examiner cites paragraph [0064] of Kuzuhara, which recites the mixed fatty acid cellulose ester film having a thickness of from 30 to 110 microns. In contrast, in the present application, claim 9 requires a thickness of 15 to 40 microns, claim 26 requires a thickness of 10 to 50 microns and claim 27 requires a thickness of 15 to 40 microns. Thus, again, Kuzuhara teaches the use of thicknesses much larger than those claimed, and no motivation is provided to modify the disclosure of Kuzuhara to arrive at the claimed ranges. Furthermore, there is no reasonable expectation of success that such a modification will allow one to arrive at thinner claimed films that also have other limitations of the disputed claims.

With regard to claim 28, paragraph [0169] of Kuzuhara does not say that the thickness of the mixed fatty acid cellulose ester film may be adjusted outside the stated thickness range and no motivation is provided to modify the disclosure of Kuzuhara to arrive at the claimed ranges. Furthermore, there is no reasonable expectation of success that such a modification will allow one to arrive at thinner claimed films that also have other limitations of the disputed claims.

Therefore, independent claims 1, 26 and claims dependent thereon are not obvious over Kuzuhara in view of Hommes for at least the foregoing reasons. Applicants respectfully request reconsideration and withdrawal of these claim rejections.

3. Rejection of claims 10 and 13-23 under 35 USC 103(a) over Kuzuhara in view of Hommes and further in view of Umemoto

The Examiner has rejected claims 10 and 13-23 under 35 U.S.C. 103(a) as being unpatentable over Kuzuhara in view of Hommes and further in view of Umemoto US 6,659,615 ("Umemoto"). The Applicants traverse the Examiner's rejection and respectfully submit that the

cited references not teach, explicitly or inherently, all elements of any of the pending claims, and that it would not be obvious to a person of ordinary skill in the art to modify their disclosure to arrive at the subject matter of the pending claims with a reasonable expectation of success.

As explained above, Kuzuhara, for example, fails to disclose or suggest polymers that include a crystallization modifier. The polymers listed in the cited reference are amorphous polymer systems that do not exhibit a significant degree of crystallization. Furthermore, Kuzuhara does not teach the claimed retardance ranges. Hommes does not fill the gaps in the disclosure of Kuzuhara, as it also does not teach or suggest a layer of simultaneously biaxially stretched polyolefin or polymer including a crystallization modifier that has an in-plane retardance (R_e) being 100 nm or less and an absolute value of an out-of-plane retardance (R_{th}) being 55 nm or greater. With regard to claim 10, Kuzuhara does not teach or suggest the use of polyolefin films and, instead, teaches away from using polycarbonate films due to inability to make them uniform. (Kuzuhara, paragraph [0007]).

The Examiner admits that Kuzuhara does not teach a film where “the in-plane and out-of-plane retardance are substantially uniform across the length and width,” as required by claims 10 and 13. The Examiner asserts, however, that Umemoto teaches desirability of reducing variation of in-plane retardation, and that the disclosure of Umemoto can be extended to reducing the variation of out-of-plane retardation. The Applicants respectfully disagree. Umemoto is directed to a light pipe including a transparent resin plate having a specified in-plane retardation, but it does not contain any teaching or suggestion as to the out-of-plane retardation of the resin plate or of any other components of the light pipe. Thus, a person of ordinary skill in the art would not be motivated to use the disclosure of Umemoto to derive any information about out-of-plane retardation. Furthermore, there would be no reasonable expectation of success of such a combination satisfying all elements of the present claims.

With regard to claims 14 and 15, the Examiner has admitted that Kuzuhara does not teach a film with in-plane and out-of-plane retardances substantially uniform across the length and width. As explained above, Umemoto does not supply the missing limitation. In addition, claims 14 and 15 require that the length and width of the film is at least 1.3 m and 1.5 m, respectively. Neither Kuzuhara nor Umemoto teach the claimed lengths and widths. Contrary to the Examiner’s suggestion that extending the width of the film would be obvious, the references

contain no motivation for such a modification. Furthermore, there is no reasonable expectation of success of such a modification that would also satisfy other elements of the claims, e.g., the uniformity requirements.

With regard to the rejection of claims 16-18, the Examiner admits that the references do not disclose the additional limitations. In addition, the Applicants respectfully submit that absent impermissible hindsight reconstruction, it would not be obvious to modify the disclosure of the references to arrive at the Applicants' films with the specific uniformity requirements recited in claims 16-18, especially in the absence of any teaching of the need for the out-of-plane retardance uniformity. Furthermore, there is no reasonable expectation that one of ordinary skill in the art would be able to use the reference teachings and successfully make the films with these uniformity requirements.

In summary, claims 10 and 13-23 are not obvious over Kuzuhara in view of Hommes and further in view of Umemoto for at least the foregoing reasons. Applicants respectfully request reconsideration and withdrawal of these claim rejections.

4. Rejection of claims 11, 12, 24, 25, 33 and 34 under 35 USC 103(a) over Kuzuhara in view of Hommes and Umemoto and further in view of Hebrink

The Examiner has rejected claims 11, 12, 24, 25, 33 and 34 under 35 U.S.C. 103(a) as being unpatentable over Kuzuhara in view of Hommes and Umemoto and further in view of Hebrink et al. US 2003/0072931 ("Hebrink"). The Applicants traverse the Examiner's rejection and respectfully submit that for at least the foregoing reasons the cited references not teach, explicitly or inherently, all elements of any of the pending claims, and that it would not be obvious to a person of ordinary skill in the art to modify their disclosure to arrive at the subject matter of the pending claims with a reasonable expectation of success.

In addition, the cited paragraphs of Hebrink refer to subject matter completely different from the present application. Paragraph 100 refers to matching viscosity between first and second layers of multilayer optical films, while paragraph 112 refers to skin layers that may be included into multilayer optical films. Again, absent impermissible hindsight reconstruction, a person of ordinary skill in the art would find no motivation to combine Hebrink with other cited references to arrive at the subject matter of the present claims.

Thus, claims 11, 12, 24, 25, 33 and 34 are not obvious over Kuzuhara in view of Hommes and Umemoto and further in view of Hebrink for at least the foregoing reasons. Applicants respectfully request reconsideration and withdrawal of these claim rejections.

5. Nonstatutory Double Patenting Rejection

The Examiner also provisionally rejected claims 1-38 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/365,250 (Johnson et al.), claims of copending Application No. 10/364,940 (Allen et al.) and claims of copending Application No. 10/365,332 (Roska et al.). Without acquiescing to the Examiner's position but to facilitate prosecution and allowance of this case, the Applicants are filing terminal disclaimers (enclosed herewith) over Application No. 10/365,250 (Johnson et al.), Application No. 10/364,940 (Allen et al.) and Application No. 10/365,332 (Roska et al.). Accordingly, the Applicants request withdrawal of these rejections.

It is respectfully urged that the claims now pending before the Examiner are in condition for allowance. A notification of allowability is respectfully solicited. Should the Examiner determine that a telephone interview would be beneficial in resolving any of the issues in this case, the Examiner is invited to telephone the undersigned attorney at the telephone number noted below. In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 1-40, as amended, at an early date is solicited.

Respectfully submitted,

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Date

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